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Roberts
PATENT

Customer No. 22,852
Attorney Docket No. 02734.0506

Electio

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Kambiz B. MAKOUI et al.

Serial No.: 08/733,072

Filed: October 16, 1996

For: EMBOSsing SYSTEM
INCLUDING SLEEVED ROLLS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

RESPONSE TO RESTRICTION REQUIREMENT

In a restriction requirement dated October 7, 2003, the Examiner required restriction under 35 U.S.C. § 121 between:

Group I - Claims 78-96 and 108-142, drawn to an embossing apparatus, classified in Class 101, subclass 23;

Group II - Claims 97-107, drawn to a system for positioning an embossing roll, classified in Class 101, subclass 376; and

Group III - Claims 143-147, drawn to an embossing roll positioning apparatus, classified in Class 101, subclass 376.

Applicants provisionally elect, with traverse, to prosecute Group I, Claims 78-96 and 108-142, drawn to an embossing apparatus, classified in Class 101, subclass 23.

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The Examiner's attention is directed to M.P.E.P. § 803, which sets forth criteria and guidelines for Examiners to follow in making a proper requirement for restriction. A restriction requirement is proper only if in the absence of restriction there is a serious burden on the Examiner in examining all of the claims. (See MPEP §§ 803.02, 806.04(a) - (j), 808.01(a) and 808.02). It would not constitute an undue burden to search the subject matter as claimed.

If the search and examination of an entire application can be made without serious burden the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.

M.P.E.P. § 803.02 (emphasis added).

First, Applicants submit that no serious burden exists in searching the entire application, as the Examiner has acknowledged by classifying each of the Groups in the same class, with Groups II and III even being classified in the same subclass. Second, Applicants submit that the search required to properly examine the elected subject matter would necessarily involve an overlapping search of the entire subject matter presently claimed, including the claims of all of Groups I-III. Specifically, Group II includes claims directed to a system for selectively positioning an embossing roll, including a sleeve positioned on an elongated core that is capable of being expanded by communication of pressurized air from a central bore of the core to an outer surface of the core. Moreover, Group III includes claims directed to an embossing roll positioning apparatus, including a sleeve positioned on an elongated core that is capable of being expanded by communication of pressurized air to the outer surface of the core. Claim 90, which is included within the elected Group I, is directed to a

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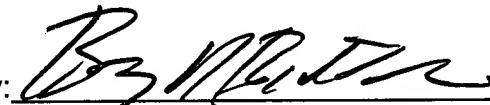
embossing apparatus, including an embossing roll having a sleeve positioned on an elongated core that is capable of being expanded when pressurized air is passed to the surface of the core.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: October 30, 2003

By: 
Barry D. Biddle
Reg. No. 44,033

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